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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,962	06/21/2006	Reinhold Braam	112740-1139	9725
29177	7590	06/18/2009		
K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER KHAN, MEHMOOD B	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 06/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,962

Applicant(s)

BRAAM ET AL.

Examiner

MEHMOOD B. KHAN

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02/13/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "...services are consistent...", which is not recited or stated anywhere in the submitted specification. Thus claims contain new matter.

Claims 17 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The amended claims recite limitations, as stated above, are/is not recited nor stated in the submitted specification and thus does not enable one of ordinary skill in the

art to determine the scope of the claims. The instant application does have support for services throughout the originally submitted specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Naddell et al. (US 5,613,213 herein Naddell).

Claim 17, Naddell a mobile communication terminal for operation of at least two mobile radio communication systems in respectively associated mobile radio networks (**Fig. 1: 101, 102, 108, where Naddell discloses system A, system B and mobile unit**), comprising: Naddell discloses each said mobile radio communication system operable to provide a user of said mobile communication terminal with a plurality of services of different types (**Fig. 1: 108, 101, 102, Fig. 2: 208, 209, where Naddell discloses a mobile phone in communication with two different networks offering different services**), Naddell discloses wherein said mobile communication terminal is connected to receive and effect further processing of a plurality of data records wherein each said data record is associated with one respective type of said services (**Col 2: 14-23, where Naddell discloses sending information to a mobile regarding services from different radio communication systems; Col 3: 41-48, Fig. 2: 201, where**

Naddell discloses a controller and processing of indicators), Naddell discloses wherein said services are consistent for at least two mobile radio communication systems (**Col 3: 28-32, Fig. 2: 209, where Naddell discloses services available in two networks**); Naddell discloses a list of service types said list comprising said services of the same type which are repeatedly provided by said mobile radio networks, said services stored using said data records, said data records containing information used by said services to be assessed by a user (**Fig. 2: 205, 207, 208, 209, where Naddell discloses a memory, table, systems and services; Col 2: 12-21, where Naddell discloses information, i.e. records, decoded to display services to a user**).

Claim 22, Naddell discloses at least two mobile radio networks, each said mobile radio network associated with a radio communication standard (**Fig. 1: 101, 102, where Naddell discloses system A and system B; it is well known in the art that mobile networks incorporate standards such as GSM, IS-95, etc.**), Naddell inherently discloses each said mobile radio network further comprising a plurality of mobile communication terminals (**It is well known that mobile radio networks have multiple users, thus plurality of mobile communication terminals**), Naddell discloses wherein each said mobile communication terminal is operable for at least two mobile radio networks (**Col 2: 14-23, where Naddell discloses sending information to a mobile regarding services from different radio communication systems, thus operable in more than one system**), Naddell discloses each said mobile radio network

providing a user of said mobile communication terminal with a plurality of services of different types (**Col 2: 14-23, where Naddell discloses sending information to a mobile regarding services from different radio communication systems**); Naddell discloses wherein at least two said mobile radio networks are operable for transmitting data records (**Col 2: 14-23, where Naddell discloses sending information to a mobile from different radio networks**), Naddell discloses each said data records associated with a plurality of said services, and said data records contain information used by said services to be assessed by a user (**Col 2: 12-21, where Naddell discloses information, i.e. records, decoded to display services to a user**), and wherein said services are consistent for at least two said mobile radio networks (**Col 3: 28-32, Fig. 2: 209, where Naddell discloses services available in two networks**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naddell in view of Seppanen et al. (US 5,903,832 herein Seppanen).

Claim 18, Naddell does not explicitly disclose wherein entries in said list of service types have different priority among each other.

In an analogous art, Seppanen discloses wherein entries in said list of service types have different priority among each other (**Col 4: 2-4, where Seppanen discloses selecting networks from a prioritized list**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Naddell to prioritize networks with services as taught Seppanen so as to allow the user to select from a prioritized list (**Col 3: 49-50**).

Claim 19, Naddell does not explicitly disclose wherein an assessment criterion is defined for the priority.

In an analogous art, Seppanen discloses wherein an assessment criterion is defined for the priority (**Col 4: 5-9, where Seppanen discloses different priorities of different networks**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Naddell to prioritize networks with services as taught Seppanen so as to allow the user to select from a prioritized list (**Col 3: 49-50**).

Claim 20, Naddell does not explicitly disclose wherein the assessment criterion is user-defined.

In an analogous art, Seppanen discloses wherein the assessment criterion is user-defined (**Col 4: 15-20, where Seppanen discloses programming priority**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Naddell to prioritize networks with services as taught Seppanen so as to allow the user to select from a prioritized list (**Col 3: 49-50**).

Claim 21, Naddell discloses wherein said mobile communication terminal is operable such that said list of service types can be shown on a display device on said mobile communication terminal (**Abstract, where Naddell discloses displaying on a display**), Naddell discloses further comprising selection means for selecting a service of a desired service type from said list **Fig. 3: 301, 306, where Naddell discloses choosing of a system**).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEHMOOD B. KHAN whose telephone number is (571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B. K./
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617